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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,225	05/02/2001	David S. Gress	95-460	7396

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EXAMINER	
RAMOS FELICIANO, ELISEO	
ART UNIT	**PAPER NUMBER**
2681	8

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/846,225	Applicant(s) GRESS ET AL.	
	Examiner Eliseo Ramos-Feliciano	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification/Drawings

1. Previous objection to the drawings is withdrawn in view of amendment to the specification filed on April 2, 2004.

2. The drawings are objected to because of the problems addressed in the "Notice of Draftsperson's Patent Drawing Review" (PTO-948 form). Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1, 3-5, 7-8, 12, 14, 16, 20, 22-24, 26-27, 31, 33-35, 37-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwelb et al. (US Patent Number 5,950,123), in view of Jones (US Patent Number 5,832,221) and further in view of Luther (US Patent Number 5,640,590).

Regarding **claims 1, 12, 20, and 31**, Schwelb et al., discloses a method in a server configured for executing messaging operations, the method comprising: receiving a short message service (SMS) that specifies text-based message, a messaging destination, and outputting the audible message for delivery to the messaging destination (column 6, lines 9-20). Schwelb does not disclose receiving a short message service (SMS) message that specifies a text-to speech messaging command. However, Jones teaches receiving a message that specifies a text-to speech messaging command (column 8, lines 51-59). Therefore, at the time of invention,

it would have been obvious to a person of ordinary skill in the art, to modify Schwelb with the above teachings of Jones, so the sender has the option to tell server to convert to voice when sender knows the preferred format (as suggested by Jones, column 8, 51-55). Schwelb does not disclose detecting the text to speech messaging command during parsing of the SMS message; invoking a text-to speech resource for conversion of the text-based message into an audible message in response to detecting the text-speech messaging command. However, Luther discloses detecting the text to speech messaging command during parsing of the message; invoking a text-to speech resource for conversion of the text-based message into an audible message in response to detecting the text-speech messaging command (column 4, lines 24-30, and lines 51-54, see also blocks 302 and figure 3 and S318 in figure 3b). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to modify Schwelb with the above teachings of Luther, in order to avoid desynchronization as suggested by Luther (column 4, lines 24-30).

Regarding **claims 3, 22, and 33**, the combination of Schwelb, Jones, and Luther further discloses the detecting step includes detecting the text-to-speech messaging command as prescribed character within the SMS message (Luther - column 3, lines 43-53, and column 4, lines 23-29).

Regarding **claims 4, 23, and 34**, the combination of Schwelb, Jones, and Luther further discloses the detecting step further includes detecting the text-to-speech messaging command (Luther - column 4, lines 24-30) except for the text-to-speech command being adjacent to the messaging destination. Since applicant has not disclosed that this limitation solves any stated problem or is for any particular purpose, it would have been obvious to a person of ordinary skill

in the art, to place the command next to the message destination, in order to allow the server to easily detect the text-to-speech command.

Regarding **claims 5, 14, 24, and 35**, the combination of Schwelb, Jones, and Luther further discloses the invoking step includes issuing a procedure call to the text-to-speech resource, the text to speech resource executable within the server (Jones element 750 in figure 1, also see column 9, lines 54-61, and Luther- column 4, lines 23-30).

Regarding **claims 7, 26, and 37**, the combination of Schwelb, Jones, and Luther further discloses the outputting step includes outputting a notification message, including the audible message and specifying the message destination, to a notification resource configured for notifying the messaging destination with the audible message (Jones - column 8, lines 39-61).

Regarding **claims 8, 27, and 38**, the combination of Schwelb, Jones, and Luther further discloses the outputting step further includes generating the notification message including the audible message, the messaging destination, and a prescribed command specifying immediate notification the messaging destination (Jones - column 9, lines 42-53).

Regarding **claim 16**, see the rejection of *claims 7 and 8* as discussed above.

5. **Claims 6, 9-11, 13, 15, 17-19, 25, 28-30, 36, and 39-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over by Schwelb et al., Jones, and Luther, as applied above, and further in view of Spielman et al. (US Patent Number 6,665,378).

Regarding **claims 9, 17, 28, and 39**, the combination of Schwelb, Jones, and Luther discloses the outputting step further includes outputting a notification message (Jones - column 9, lines 42-53). The combination of Schwelb, Jones, and Luther does not disclose notification message is according to SMTP protocol. However, Spielman discloses notification message is

according to SMTP protocol (column 5, lines 21-32). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Schwelb, Jones, and Luther with the above teaching of Spielman, so that the message notification can be sent using e-mail message (as suggested by Spielman, column 5, lines 25-29).

Regarding **claims 10, 18, 29, and 40**, the combination of Schwelb, Jones, Luther, and Spielman further discloses obtaining an e-mail destination for the notification message by accessing a subscriber profile directory based on the messaging destination and according to LDAP protocol. (Spielman - column 7, lines 40-51).

Regarding **claims 6, 11, 15, 19, 25, 30, 36, and 41**, the combination of Schwelb, Jones, and Luther discloses the outputting step (Jones - column 9, lines 42-53). The combination of Schwelb, Jones, and Luther does not disclose the outputting step includes: requesting a voice over IP resource to establish an audible connection with the messaging destination; and playing the audible message in response to establishment of the audible connection. However, Spielman discloses the outputting step includes: requesting a voice over IP resource to establish an audible connection with the messaging destination; and playing the audible message in response to establishment of the audible connection (column 5, lines 41-47). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Schwelb, Jones, and Luther with the above teaching of Spielman, so that the voice over IP calls can be made (as suggested by Spielman, column 5, lines 41-47).

Regarding **claim 13**, the combination of Schwelb, Jones, Luther further discloses the interface is configured for receiving the SKIS message (Schwelb - column 6, lines 920). The combination of Schwelb, Jones, Luther does not disclose the interface is configured for receiving

the SIVIS message according to SIVIPP protocol. However, Spielman discloses the interface is configured for receiving the SIVIS message (column 1, lines 50-57). Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Schwelb, Jones, and Luther with the above teaching of Spielman, so that existing and established standards such as SMPP can be used for receiving SIVIS messages.

6. **Claims 2, 21, 32, and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over by Schwelb et al., Jones, and Luther, as applied above, and further in view of Ladd (US Patent Application Publication Number US-2003/0078989-A1).

7. Regarding **claims 2, 21, 32, and 42**, the combination of Schwelb et al., Jones, and Luther discloses everything claimed as applied above (see rejection of *claims 1, 12, 20, and 31*). However, they fail to specifically disclose determining that the SMS message includes a destination number that corresponds to an SMS command processor within the server. Ladd discloses SMS messages (par. 0022). In a server, the message is processed by a text-to-speech processor (par. 0035). Inherently, the message must contain the processor's "destination number" in order to be properly processed. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Schwelb et al., Jones, and Luther with the above teaching of Ladd, so that the SMS message includes a destination number that corresponds to an SMS command processor within the server, in order to be properly processed.

Response to Arguments

8. Applicant's arguments filed April 2, 2004 have been fully considered but they are not persuasive.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., (1) an originator of the SMS message can request conversion of the text-based message into an audible message, regardless of message type preferences for the messaging destination (p.13, lines 9-10); (2) enabling the sender of the SMS message to request text-to-speech to be performed merely by sending the SMS message (as if automatic) (p.16, lines 12-13)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

11. In response to applicant's argument that Luther is non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the common field to Schwelb et al. and Jones is text-to-speech messaging.

Allowable Subject Matter

12. The indicated allowability of *claims 2, 21, 32, and 42* is withdrawn in view of the newly discovered reference(s) to Ladd (US Patent Application Publication Number US-2003/0078989-A1). Rejections based on the newly cited reference antecede.

Conclusion

13. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A. Gary, can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER 6/10/04

ERF/erf
June 10, 2004